

REMARKS

Status

This application was filed on August 8, 2001. The application is directed to roast and ground coffee compositions that comprise previously processed coffee grounds that contain at least about 2% lipids. (See p. 3 of the specification.) The application is also directed to processes for making brewed coffee beverages utilizing composition containing roast and ground coffee and processed coffee grounds.

The present Action sets forth a restriction requirement (setting forth 2 allegedly distinct inventions). No claim amendments are requested in this paper.

Restriction Requirement

The Examiner asserts that the following two (2) distinct inventions are claimed:

Group I: Claims 1-11, drawn to compositions or articles of manufacture for preparing brewed coffee.

Group II: Claims 12-23, drawn to a method for making brewed coffee in the form of an extract, concentrate or soluble particles.

Applicants elect to prosecute the subject matter of Group I. However, Applicants traverse the restriction requirement for the following reasons.

MPEP §803 sets forth the criteria for any restriction requirement, providing that:

There are two criteria for a proper requirement between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is not required.

In addressing the first requirement of §803, the Examiner asserts that the inventions encompassed by Groups I and II are distinct from each other (as opposed to independent). The Examiner states that the inventions of Groups I and II are related as a product and a process of making that product. Referencing MPEP §806.05(f) (subsection A in particular), the Examiner states that restriction is proper because

the product may be made by a process wherein the coffee product is produced by contacting roasted and ground coffee with water, collecting a brewed coffee, and subsequently adding processed coffee grounds to the brewed coffee.

MPEP §806.05(f)(A) provides in relevant part that process of making and product made claims may be directed to distinct inventions if "the product *as claimed* can be made by another and materially different process." (Emphasis in original.) Thus, when applying subsection (A) of §806.05(f) to the present claims, the question is whether the compositions of Claims 1-11 (i.e., containing roast and ground coffee and processed coffee grounds) can be made by a method materially different from that set forth in process Claims 12-23.

Applicants respectfully submit that the Examiner has not described a situation where the claimed product can be made by a different process from the ones claimed. Rather, the Examiner's alternate process is one for making brewed coffee, not the compositions that are used to make brewed coffee which are the Group I subject matter. As such, the Examiner has not properly demonstrated that Groups I and II are directed to distinct inventions, as required by subsection (1) of MPEP §803.

Furthermore, as to the second requirement of MPEP §803, there is no indication that a serious burden will be placed on the Examiner if restriction is not required. Indeed, it would seem that a search of product Claims 1-11 would concurrently include a search sufficient to assess the patentability of Claims 12-23.

For the foregoing reasons, Applicants request the Examiner to withdraw the restriction requirement.

Respectfully submitted,

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